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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,996	03/13/2001	Hiroyuki Sekihata	1095.1170/JDH	9371
21171	7590	12/18/2007	EXAMINER	
STAAS & HALSEY LLP			CHANDLER, SARA M	
SUITE 700			ART UNIT	
1201 NEW YORK AVENUE, N.W.			PAPER NUMBER	
WASHINGTON, DC 20005			3693	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/803,996

Applicant(s)

SEKIHATA ET AL.

Examiner

Sara Chandler

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,6-10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6-10 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

This Office Action is responsive to Applicant's arguments and request for reconsideration of application 09/803,996 (03/13/01) filed on 11/13/07.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1, 6-10 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Epixtech website, 8/24/2000, <http://web.archive.org/web/20000229101319/http://www.epixtech.com/>. (hereinafter Epixtech) in view of

"How the virtual library transforms interlibrary loans- the OhioLINK experience," by David F. Kohl. Interlending & Document Supply. Bradford: 1998. Vol. 26, Iss. 2. (hereinafter Kohl) and

"The Washington Research Library Consortium: A real organization for a virtual library," by Lizanne Payne. Information Technology and Libraries. Chicago: Mar 1998. Vol. 17, Iss. 1. (hereinafter Payne).

**Re Claim 1:** Epixtech discloses a book management apparatus for managing book stocks of a plurality of individual libraries through a network, comprising:  
book stock information management means for managing book stock information which is information about book stocks of individual libraries (see e.g., Dynix Features - personal bibliographies);  
bibliographic information management means for managing bibliographic information comprising attributes of books managed by said book stock information management means (see e.g., Dynix Features - personal bibliographies);  
loan information management means for managing loan information about a loan of the book stocks of the individual libraries (see e.g., circulation features of Dynix, Horizon);  
ordering information management means for managing ordering information on books newly ordered from the individual libraries (e.g., Dynix Technical Services - Acquisitions and Electronic Ordering; Horizon Technical Services - Acquisitions - serial links)(it is noted that this is shown on p. 2 of the Horizon printout which is out of order and is the last page of the document).;  
ordering means for placing an order with a book wholesaler, based on the ordering

information managed by the ordering information management means (e.g., Dynix Technical Services - Acquisitions and Electronic Ordering; Horizon Technical Services - Acquisitions - serial links)(it is noted that this is shown on p. 2 of the Horizon printout which is out of order and is the last page of the document).;

loan reserving means for registering a book in said book stock information management means as a loan reserved book when a request for loan reserving is entered (e.g., Dynix Technical Services - Acquisitions and Electronic Ordering; Horizon Technical Services - Acquisitions - serial links)(it is noted that this is shown on p. 2 of the Horizon printout which is out of order and is the last page of the document). It further shows that the loan information management means enable a library to modify the loan information of another library since it checks books in and out on interlibrary loan and enters their status and since all data lending and borrowing information are maintained in a single database (see e.g., press release~p.2, 1st par., Dynix and Horizon), and wherein, when a loan of a book is conducted between different libraries, said loan information management means enables a predetermined library to modify the loan information of another library (e.g., Dynix Technical Services - Acquisitions and Electronic Ordering; Horizon Technical Services - Acquisitions - serial links)(it is noted that this is shown on p. 2 of the Horizon printout which is out of order and is the last page of the document). It further shows that the loan information management means enable a library to modify the loan information of another library since it checks books in and out on interlibrary loan and enters their status and since all data lending and

borrowing information are maintained in a single database (see e.g., press release~p.2, 1st par., Dynix and Horizon).

Epixtech fails to explicitly disclose:

collation information receiving means for generating collation information when a book ordered by the ordering means has been previously ordered by another individual library, said collation information including information identifying each individual library that has ordered the books;

collation information transmitting means for transmitting the collation information generated by the collation information receiving means to the wholesaler; and wherein said book stock information management means registers an information whether the book is collated or not to said book stock information based on said ordering information and said collation information, and

said loan reserving means registers a book in said book stock information management means as a loan reserved and unavailable book when the requested book is not yet delivered.

Kohl discloses:

collation information receiving means for generating collation information when a book ordered by the ordering means has been previously ordered by another individual library, said collation information including information identifying each individual library that has ordered the books (Kohl, pgs. 1-5, particularly 3-4);

collation information transmitting means for transmitting the collation information generated by the collation information receiving means to the wholesaler (Kohl, pgs. 1-

5, particularly 3-4); and wherein

said book stock information management means registers an information whether the book is collated or not to said book stock information based on said ordering information and said collation information (Kohl, pgs. 1-5, particularly 3-4).

It would have been obvious to one of ordinary skill in the art to further modify Epixtech by adding the elements of Kohl in order streamline the ordering process and to track and close out the fulfillment process. As Kohl suggests, it would reduce unnecessary duplication, provide cost savings, and thus allow for the overall expansion of the networks collection coverage.

Payne discloses:

wherein, said loan reserving means registers a book in said book stock information management means as a loan reserved and unavailable book when the requested book is not yet delivered (Payne, pgs. 1-6, particularly pgs. 1-2). It would have been obvious to one of ordinary skill in the art to further modify Epixtech and Kohl by adopting the teachings of Payne in order to allow patrons to browse information about upcoming titles and receive them soon after they come out.

**Re Claim 6:** Epixtech in view of Kohl and Payne discloses the claimed invention supra and Payne further discloses wherein said ordering means places an order at a price reduced in accordance with an order quantity (Payne, pgs. 1-6, particularly pgs. 1-2).

Alternatively, the examiner takes official notice that it is notoriously old and well known in the art to place an order at a price reduced in accordance with an order quantity. It

would have been obvious to one of ordinary skill in the art to further modify the apparatus of Epixtech in view of Kohl and Payne by placing an order at a reduced price based on quantity in order to save money.

**Re Claim 8:** Epixtech in view of Kohl and Payne discloses the claimed invention supra and Epixtech further discloses:

statistical information generating means for looking up the loan information managed by said loan information management means or the ordering information managed by said ordering information management means, to generate statistical information about loan or ordering of books (e.g., Resource Sharing System, 5th paragraph; Executive Information System); and

providing means for providing the statistical information generated by said statistical information generating means to the individual libraries (e.g., Resource Sharing System, 5th paragraph; Executive Information System).

**Re Claim 9:** Epixtech in view of Kohl and Payne discloses the claimed invention supra and Epixtech further discloses:

request receiving means for receiving a request from a user (see e.g., press release~p.1, 5th par., Dynix- Patron Self Services, Horizon, Resource Sharing System- Patron Satisfaction);

searching means, responsive to reception of a request for search for a book by said request receiving means, for searching the book stock information for information about a matching book (see e.g., press release~p.1, 5th par., Dynix- Patron Self Services, Horizon, Resource Sharing System- Patron Satisfaction); and



search result transmitting means for transmitting a result of search by said searching means to the user from whom the request has been received (see e.g., press release~p.1, 5th par., Dynix- Patron Self Services, Horizon, Resource Sharing System- Patron Satisfaction).

**Re Claim 10:** Epixtech in view of Kohl and Payne discloses the claimed invention supra but fails to explicitly disclose:  
keyword registration means for registering a predetermined keyword if book stock information matching the book was not found by said searching means; and  
newly registered information transmitting means, responsive to new registration into the book stock information of a book matching the keyword registered by said keyword registration means, for transmitting the newly registered information about the book to a user with respect to whom the keyword has been registered. However, the examiner takes official notice that it is notoriously old and well known in the art to register a SDI keyword and receive information when a new book corresponding to that keyword is registered. It would have been obvious to one of ordinary skill in the art to do so in order to provide the user with relevant information automatically, saving labor.

**Claim 12** contains features or limitations recited in claim 1 and is rejected under the same rationale.

**Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Epixtech in view of Kohl and Payne as applied to claim 1 above, and further in view of Rubin US Pat. No. 6,078,897.

Epixtech in view of Kohl and Payne discloses the claimed invention supra but fails to explicitly disclose a reduced price estimating means for looking up the ordering information managed by said ordering information management means, to estimate a reduced price of a book which a library is going to order. Rubin discloses a reduced price estimating means for looking up the ordering information managed by said ordering information management means, to estimate a reduced price of a book which a library is going to order (Rubin, Figs. 2-3, abstract, col. 1, line 44+ - col. 2, line 46, col. 3, line 16+ - col. 5, line 25; col. 6, line 13+ - col. 8, line 47; col. 9, lines 1-12). It would have been obvious to one of ordinary skill in the art to further modify Epixtech, Kohl and Payne by using the discount estimator of Rubin et al in order more easily facilitate the use of volume discounts.

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive.

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It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the field of endeavor is the "managing book stocks of a plurality of libraries through a network." (See applicant's specification, pg. 1, lines 5-10). Epixtech, Kohl and Payne are all in the same field of endeavor and relate to systems for managing book stocks between a plurality or consortia of libraries.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, see citations *supra* and remarks below.

Re Claims 1 and 6-10: Applicant argues the prior art fails to disclose, collation information receiving means for generating collation information when a book ordered by the ordering means has been previously ordered by another individual library, said collation information including information identifying each individual library that has ordered the books;

collation information transmitting means for transmitting the collation information generated by the collation information receiving means to the wholesaler;

Re Claim 12: Applicant argues the prior art fails to disclose: generating collation information when an ordered book has been previously ordered by another individual library, said collation information including information identifying each individual library that has ordered the book;  
transmitting the collation information to the wholesaler;

Claims 1 and 6-10 were rejected by Epixtech in view of Kohl and Payne. See citations *supra*.

Claim 12 was rejected by Epixtech in view of Kohl and Payne. See citations supra.

Collation/collating can mean many things including to compare carefully or to assemble in correct sequence. In the claimed invention, the "collation information" is said to include information identifying each library that has ordered a book.

As the following remarks elaborate, Kohl covers the above cited features of the claimed invention. The claimed invention is describing creating a record (i.e., of the comparison of or sequence of) books ordered that are already held by and/or have been ordered by a library in the network, transmitting this information at the time of ordering and using this information as part of the management of books held in the collection. It would have been obvious to modify Epixtech in light of the teachings, motivation and suggestions of Kohl.

Kohl teaches a plurality of functions related to the management of book stocks in the context of a system linking a plurality of libraries in a consortium. Kohl describes how listings of the holdings for each individual library in the consortium can be obtained (e.g., see Kohl, pgs. "How does the system work?" Kohl further describes how in a consortium of Ohio libraries, 60 percent of the book titles were held by more than one library. Kohl suggests, that coordinating the collection development among the libraries in the Ohio consortium would help reduce unnecessary duplication, provide cost savings, and with the money saved allow for the expansion of coverage for the Ohio consortium as a whole. In other words, as each individual library orders or otherwise obtains books to add to its own collection, a coordinated system is needed to know what

is already held by the consortium as a whole (e.g., see Kohl, pgs. 3-4, "Implications for collection development.?). See also citations supra.

Re Claims 1 and 6-10: Applicant argues the prior art fails to disclose, wherein, said loan reserving means registers a book in said book stock information management means as a loan reserved and unavailable book when the requested book is not yet delivered.

Re Claim 12: Applicant argues the prior art fails to disclose: a book is registered in said book stock information management means as a loan reserved and unavailable book when the requested book is not yet delivered.

Claims 1 and 6-10 were rejected by Epixtech in view of Kohl and Payne. See citations supra.

Claim 12 was rejected by Epixtech in view of Kohl and Payne. See citations supra.

Payne covers the aboved cited features of the claimed invention. Payne describes a system in which the functions of circulation, cataloging and acquisitions are fully integrated between the member libraries. In Payne, the status of materials held by each member library is updated with up-to-the-minute information. In other words, as materials (e.g., books) held by the consortium become available or unavailable to users of a library because they have been reserved by another user of one of the member libraries, the change in status is modified in real-time (e.g. see Payne, pg. 3, "Programs"). It would have been obvious to one of ordinary skill in the art to modify the teachings of Epixtech and Kohl by adopting the teachings of Payne to allow patrons to

browse information about upcoming titles and receive them soon after they come out. Without a coordinated, real-time system between the member libraries there would be inaccuracies with respect to what information is available and undue delay caused by the need to check the status of information. See also citations *supra*.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

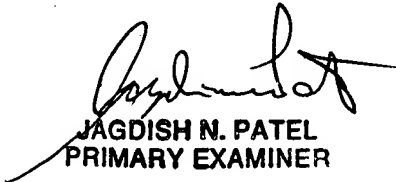
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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SMC



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